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10/085,430	02/28/2002	Glen Edward Gould	8285-502	4865

7590

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EXAMINER

PAK, SUNG H

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,430

Applicant(s)

GOULD ET AL.

Examiner

Sung H. Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

All references submitted in the information disclosure statement have been considered by the examiner.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al (US 4,846,565).

Swanson et al reference was cited in the information disclosure statement.

Swanson et al reference discloses a fiber optic patch device with all the limitations set forth in the claims, except it does not teach a housing containing a portion of the fiber optic cable. Specifically, Swanson et al discloses: regarding claims 1, 5-7, a fiber optic patch cable having first and second ends ("16" Fig. 1); regarding claim 3, a first mechanical fiber optic splicer disposed in an enclosure adapted to be coupled with the first end of the fiber optic cable and the first end of the fiber optic patch (Fig. 4); a second mechanical fiber optic splicer disposed in an enclosure adapted to be coupled with the second end of the fiber optic cable and the second end of the fiber optic patch (Fig. 4); regarding claim a water-tight splice housing defining an internal cavity (Figs. 5-6), the internal cavity being adapted to receive the first and second mechanical fiber optic splicers disposed in enclosures, the fiber optic patch (Fig. 5, column 7 line 40-column 8 line 3).

Although the housing is not designed to enclose a portion of the fiber optic cable, such modification would have been obvious to a person of ordinary skill in the art.

According to the disclosure the housing is primarily used for storing the fiber optic patch device during the delivery of the device to the repair site (column 7 lines 40-45).

However, due to the proliferation of the fiber optic use in numerous communications applications, these repairs must be made often in harsh environmental surroundings (i.e. underground, underwater environment, etc.). As such, the use of water-resistant protective housings in fiber optic splicing and fiber optic repairs is well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Swanson et al's protective housing to enclose a portion of the fiber optic cable and the housing to be deployed with the fiber optic patch at the repair site.

Regarding claims 3, the enclosures "20" and "24" in Fig. 1 can also be referred to as "splice tray."

Claims 8-12, 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al (US 4,846,565) in view of Yin et al (US 5,312,468).

Swanson et al reference discloses a fiber optic patch device with all the limitations set forth in the claims as discussed above, except it does not teach angle cleaving of fiber optic ends. Regarding claims 8 and 17, Although Swanson et al reference does not explicitly state the method of patching fiber optic cables, such method steps would be inherently met by using the device disclosed as discussed in the rejection of earlier claims.

Even though Swanson et al does not disclose the method of angle cleaving optical fiber ends as recited in claims 9-11, and 18, such method is known in the prior art as taught by Yin et al (Fig. 4, and abstract). Yin et al discuss that angled cleaves are advantageous because they minimize back reflections (column 1 lines 5-36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Swanson et al teachings to include a method of angle cleaving optical fiber ends. It would have been desirable to minimize back reflections.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,382,845.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of U.S. Patent No. 6,382,845 discloses a fiber optic patch device

with all the limitations set forth in the claims, except it additionally teaches the use of an outer protective housing.

However, the omission of outer protective housing is well known in the fiber optic splicing art. Outer protective housing is frequently omitted when fiber optic devices are deployed in an environment which does not present any harsh environmental elements. Such omission is advantageous because it decreases production and deployment costs. Therefore, it would have been obvious to a person of ordinary skill in the art to modify claimed device of U.S. Patent No. 6,382,845 to omit outer protective housing.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sung H. Pak whose telephone number is (703) 308-4880. The examiner can normally be reached on Monday - Thursday : 6:30am-5:00pm.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Sung H. Pak
Examiner
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sp
May 24, 2003



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